

SUPPORT FOR THE AMENDMENTS

Claims 1-4, 7, 8, 15, and 16 have been amended.

Support for the amendment of Claims 1-4 is provided by the corresponding claims as originally filed, the specification throughout (for example, at pages 3-4), and the Examples. The amendment of Claims 7, 8, 15, and 16 is provided by the corresponding claims as original filed.

No new matter has been added by these amendments.

REMARKS

Claims 1-21 are pending in the present application.

The rejections of: (a) Claims 1, 3, 5, and 10 under 35 U.S.C. §102(b) over JP 6-128168, (b) Claims 1, 3, 5-9, and 15-19 under 35 U.S.C. §103(a) over JP 46-39058, (c) Claims 2 and 4-9 under 35 U.S.C. §103(a) over JP 46-39058 together with JP 6-128168, and (d) Claims 1-6, 10, and 15-19 under 35 U.S.C. §103(a) over JP 6-128168, are respectfully traversed.

JP 46-39058 discloses a purified product of catechins can be obtained by taking the following steps: adding activated carbon to a catechin-containing solution obtained by extraction of tea leaves with water, acetone, ethanol and ethyl acetate, or to an alcoholic extract liquor of tea leaves, and then removing therefrom the resulting impurities (e.g. chlorophyll), followed by distillation of the solvent under a carbon dioxide gas atmosphere.

JP 06-128168 discloses that a powdered or concentrated product of tea catechins can be obtained by taking the following steps: preparing a tea extract by infiltration of dried tea leaves (100 parts by weight) into a solvent (300-600 parts by weight), or by heating tea leaves for 2 min to 12 hours, and then removing unnecessary by-products from the tea extract with activated charcoal, acid clay or diatomaceous earth before, and after, conducting a concentration of the alcoholic solution, followed by decolorization of the concentrated product.

However, JP 46-39058 fails to disclose anything more than the technique wherein an activated clay is used to treat an extract obtained by extraction of tea leaves with a specifically chosen organic solvent or water. JP 06-128168 similarly fails to disclose anything more than the technique wherein activated charcoal, acid clay or diatomaceous earth is used to treat only the alcoholic extract solution.

Accordingly, neither JP 46-39058 nor JP 06-128168 disclose or suggest the claimed method where tea extract is treated with activated carbon (and also acid clay or activated clay) in a mixed solution of an organic solvent and water (9/1 to 1/9) at the specifically claimed ratio.

Moreover, JP 46-39058 and JP 06-128168 merely disclose the removal of impurities from their extraction solutions. At no point is the specific remove of caffeine discloses or suggested by these references.

To further illustrate the benefits of the claimed invention that are not disclose, suggested, or even predictable based on the disclosures of JP 46-39058 and JP 06-128168, Applicants **submit herewith** a Declaration under 37 C.F.R. §1.132. In the Declaration, Applicants demonstrate the advantages of the claimed process which comprises treating a caffeine-containing catechin composition by use of a mixed solution containing an organic solvent and water at the specifically claimed ratio. In the Declaration, Applicants performed additional experiment using a mixed solution of an organic and water wherein the weight ratio of organic solvent to water is more than 9/1. As shown in the Tables in paragraph 7 and summarized in paragraph 8 of the Declaration, mixed solution of an organic and water wherein the weight ratio of organic solvent to water is more than 9/1 have deteriorating color tone and also suffer from persistent bitterness.

When the evidence in the Declaration are viewed together with Examples 1-4 and Comparative Examples 1-4 of the present application, the declarant provides the following summary:

As can be understood from the combined evidence of Examples 1-4 and Comparative Examples 1-4 of the present application and the above additional data Comparative Examples 10 and 11, it has been confirmed that caffeine can be removed selectively by adjusting the weight ration of organic solvent to water, each of which is contained in the mixed solution in which the caffeine-containing catechin composition is dissolved, to a range of from 9/1 to 1/9. What is more,

it is evident that the claimed process is greatly effective at obtaining a catechin composition having many advantages, such as the prevention of precipitates, improved color tone and excellently good taste.

In view of the deficiency in JP 46-39058 and JP 06-128168 fail to disclose or suggest the selective removal of caffeine as presently claimed and/or the ratio of organic solvent to water, Applicants submit that the claimed invention is not anticipated by and/or obvious in view of these references.

Accordingly, Applicants request withdrawal of these grounds of rejection.

The rejection of Claims 1-6 and 10 under 35 U.S.C. §112, first paragraph (enablement), is obviated by amendment.

The Examiner alleges that critical or essential limitations have been omitted from the claims. Specifically, the Examiner indicates that it is not clear how or if the caffeine is actually separated from the mixture. Applicants have addressed this criticism by adding the phrase “allowing said activate carbon to absorb caffeine” to Claims 1-4. Accordingly, Applicants submit that the Examiner’s criticism is moot.

Withdrawal of this ground of rejection is requested.

The rejection of Claims 1-10 under 35 U.S.C. §112, second paragraph, is obviated in part by amendment and traversed in part.

The Examiner’s first criticism also serves as the basis for the enablement rejection above. Specifically, the Examiner alleges that the claims are unclear how or if the caffeine is actually separated from the mixture. Applicants have addressed this criticism by adding the phrase “allowing said activate carbon to absorb caffeine” to Claims 1-4. Accordingly, Applicants submit that the Examiner’s criticism is moot.

The Examiner has also held that the claims are indefinite alleging that it is not clear what the range of ratios is based on. Applicants disagree and submit that the claims are clearly convey that the ratio of “9/1 to 1/9” refers to a weight ratio of the organic solvent and water in the mixed solution. As such, this criticism is without merit.

Similarly, Applicants submit that the language of Claims 7-9 is explicitly clear with respect to the ratio of “10/0 to 8/2” as relating to the weight ratio of the organic solvent and water. Further, the ratio of 10/0 is not contradictory to use of both organic solvent and water in the claim as the artisan would clearly appreciate the meaning of this phrase. Nonetheless, to improve the clarity of the claims, in the phrase “solvent of an organic solvent and water” in the first “solvent” has been deleted.

The final indefiniteness criticism by the Examiner relates to when the addition of water and distilling off of solvent in Claims 7-9 is to occur in relation to the activated carbon and clay treatment steps in Claims 1-4. Applicants respectfully submit that Claims 7-9 specifically state that the method defined therein is to produce the caffeine-containing catechin composition, which is the starting material for Claims 1-4. As such, Claims 7-9 are explicitly clear.

In view of the foregoing, Applicants request withdrawal of this ground of rejection.

Finally, with respect to the provisional obviousness-type double patenting rejections over copending US 10/581,200, Applicants make no statement with respect to the propriety of these rejections. Nonetheless, noting that it is not clear what scope of allowable subject matter exists in the present application or in the co-pending cited applications, Applicants request that these provisional obviousness-type double patenting rejections be held in abeyance. If it is determined that a Terminal Disclaimer is necessary, Applicants will consider filing the same at a later date.

The Examiner is reminded that MPEP §804 indicates that: "If "provisional" ODP rejections in two applications are the only rejections remaining in those applications, the examiner should withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer." The present application has an effective filing date of October 27, 2003, which is earlier than the effective filing date of US 10/581,200 (i.e., December 1, 2004). As such, if this provisional obviousness-type double patenting rejection is the only remaining rejection and US 10/581,200 remains pending, the Examiner shall withdraw the provisional obviousness-type double patenting rejection in this case and pass this application to allowance.

Applicants submit that the present application is now in condition for allowance.
Early notification of such action is earnestly solicited.

Respectfully submitted,

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